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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/426,111	10/22/1999	J. ROBERT MITCHELL	10991572-1	1439

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EXAMINER

BEX, PATRICIA K

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/426,111

Applicant(s)

MITCHELL, J. ROBERT

Examiner

P. Kathryn Bex

Art Unit

1743

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 September 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 03 September 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.


The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.Claim(s) objected to: NONE.Claim(s) rejected: 2-11,30-32 and 42-47.Claim(s) withdrawn from consideration: 12-28 and 3341.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 3. Applicant's reply has overcome the following rejection(s): The previous rejections under 35 U.S.C 102(b) over Winkler et al (USP 5,384,261) and 35 U.S.C 103(a) are withdrawn, in response to the arguments presented by Applicant.

Continuation of 5. does NOT place the application in condition for allowance because: Examiner does not agree that the language of claims 5 wherein each of the channels disposed between the first port and the multiple features necessarily means the channels are disposed between the first and the chamber since the features are in the chamber. This recitation is not supported within the instant specification. Throughout the specification the multiple fluid distribution channels are explicitly disclosed as being disposed "between the first port and the multiple features of the received substrate, so as direct fluid flow between the multiple regions across the first side of the received substrate", see for example paragraph bridging pages 2-3. Similarly, Applicant argues that "Fig. 4 shows array 10", Examiner points out that the reference no. 10 is the "substrate", not the "array". Secondly, Figure 5 clearly shows the chamber 36 which is "formed from housing 34 and the received substrate 10" can extend from the inlet port 42 to the outlet port 52, therefore it is not clear how the apparatus is constructed such that the distribution channels are disposed between the first port and the chamber, therefore the USC 112 1st and 2nd paragraph rejections are maintained. In response to the rejection of claim 5 under 102(b) over Freeman (WO 96/30124), Applicant argues that claim 5 requires that at least some of the channels can be chosen from the group to be closed or opened. Freeman does not allow such a selection of any of the channels 89. Examiner points out that "at least some" of the distribution channels does not exclude "all" of the channels being valves so as to be selectively closed or opened. Moreover, the language of "comprising" in the claim allows "all" the fluid distribution channels to be "valved" to be selectively opened or closed. The transitional term "comprising", is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., Genentech, Inc. v. Chiron Corp., 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997). "Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.; Moleculon Research Corp. v. CBS, Inc., 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); In re Baxter, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); E parte Davis, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts"). In response to the rejection of claims 2-4, 6, 9, 30-31 and 42 under 35 USC 102(e) over Juncosa et al (USP 6,225,109) Applicant argues that the multiple distribution channels 142 are not disposed between the first port 134 and any chamber. Examiner points to Fig. 18 which clearly shows reference no. 142 disposed between the chamber formed by housing element 138 and substrate 14 and the inlet port 134.

  
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